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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/815,313	03/22/2001	Thomas Alexander Aber	END9 0175 US1	4658

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EXAMINER

KRAMER, JAMES A

ART UNIT PAPER NUMBER

3627

DATE MAILED: 01/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/815,313	Applicant(s) ABER ET AL.	
	Examiner James A. Kramer	Art Unit 3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 102

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 4, 5, 6, 7, 10, 11, 14, 15, 16 and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Maners.

Maners teaches a remote electronic entry and validation system and method. In particular, a vender can submit an invoice to a company by entering invoice information in to a computer system located at their location (i.e. remote from the company) (column 8; lines 15-20). Examiner notes that the vendor submitting the invoice information is interpreted as preparing an invoice image and in particular preparing invoice images by converting electronic invoices received from a vendor.

Maners teaches a MicroEDI server connected via the Internet with the vendors computer system. As the vendor enters the invoice information in to their computer it is saved in the MicroEDI server of the main company (storing invoice image in an image store) (column 3; lines 60-67).

Maners goes on to teach the posting of the Invoice data. After the information is collected from the vendor, an authorization may be required from an authorizing agent of the company (column 8; lines 50-55). To accomplish this, the authorizing agent logs on to the MicroEDI application (logging on to front- end requisition and catalog server) and is able to view this image/invoice information (column 9; lines 23-53). Examiner notes that this section

Art Unit: 3627

teaches communicating invoice confirmation request to a requestor, responsive to requestor selection displaying the invoice image and advising the requestor to process confirmation by positive feedback.

Manners further teaches that the authorizing agent of the company is the individual who authorized the vendor to provide products or services to the company (column 8; lines 21-23). Further, when authorization is required the MicroEDI application looks up the contact information from the specified authorizing agent and sends a message, for example an electronic mail message to notify the authorizing agent that an invoice requires a release authorization (column 8; line 63 – column 9; line 8). Examiner notes the authorizing agent of Manners represents an individual employee of an enterprise that creates the original order.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 3 rejected under 35 U.S.C. 103(a) as being unpatentable over Maners in view of Admitted Prior Art.

Maners (as described in detail above) does not teach displaying invoices converted from electronic invoices received from a vendor into an image file having the look and feel of a paper invoice. The common knowledge or well-known in the art statement made by the Examiner in

Art Unit: 3627

the Office Action mailed 1/14/04 is taken to be admitted prior art because applicant either failed to traverse the examiner's assertion of Official Notice or the traverse was inadequate (MPEP2144.03(C)). It is therefore admitted as Prior Art for software developers to develop electronic forms that look and feel just like their paper counterparts in order provide the end user with a system they are already familiar with.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the MicroEDI application of Maners so that the invoice image presented to the authorizing user looked and felt just like a paper version in order to provide the authorizing users with a system they are already familiar with.

Claims 2, 8, 9, 12, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maners in view of Cukor et al. (hereinafter Cukor).

Maners (as described in detail above) does not teach preparing invoice images by scanning paper invoices from a vendor. Cukor teaches a system and method of processing document images. In particular, when a paper document is received it is scanned by a remote station and saved to an image file server. A microcomputer serves as a controller for the scanner and provides a data file by which transaction-related information is associated with the captured images (column 6; lines 33-36).

Cukor further teaches, in a situation where a company already has a fully operational and satisfactory computer-based system for invoicing, which includes data files containing transaction related information, associating a separate image file server to these files (column 8; lines 5-30).

Art Unit: 3627

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the MicroEDI application of Manners by including the invoice scanning and file server of Cukor and associating it with the electronic invoice information of Manners in order to allow a vendor with out Internet or computer access to submit invoice to the company and have the company process them electronically.

Response to Arguments

Applicant's arguments filed 10/28/04 have been fully considered but they are not persuasive. Applicant asserts that Manners "nowhere teaches that the "agent" must be the individual employee submitting the original requisition." Examiner respectfully disagrees and once again points to column 8; lines 21-23 and column 8; line 63 – column 9; line 8. These sections of Manners teach that an authorizing agent of a company is the individual who authorized the vendor to provide products or services to the company (column 8; lines 21-23). Further, when authorization is required the MicroEDI application looks up the contact information fro the specified authorizing agent and sends a message, for example an electronic mail message to notify the authorizing agent that an invoice requires a release authorization.

Applicant disagrees that the facts present by the Examiner as old and well known are established admitted prior art. Examiner points to MPEP 2144.03(C) which states, "If applicant does not traverse the examiner's assertion of official notice or applicant's traverse is not adequate, the examiner should clearly indicate in the next Office action that the common knowledge or well-known in the art statement is taken to be admitted prior art because applicant either failed to traverse the examiner's assertion of official notice or that the traverse was inadequate.

Art Unit: 3627

In this case, Applicant admits that no traversal was submitted following the Office action in which the official notice was made (non final action sent 1/14/04). As such the examiner, properly, clearly indicated in the following Office action (final action sent 7/28/04) that the common knowledge or well-known in the art statement was taken to be admitted prior art because Applicant failed to traverse the official notice. Therefore, facts stated by the admitted prior art statement are in fact properly established.

Examiner further notes that Applicant's present traversal is inadequate. Once again referencing MPEP 2144.03 (C), "To adequately traverse such a finding, an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art". Applicant fails to state why the noticed fact is not considered to be common knowledge.

As a result of the arguments above, Examiner's rejection in view of Admitter Prior art stands. However, Examiner recognizes Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well known are capable of instant and unquestionable demonstration as being well-known. Examiner believes the fact in this case are. In support of this Examiner has entered US Patent No 5,963,925 to Kolling et al. to the record. Kolling teaches an electronic statement presentment system which specifically presents statements that have the same "look and feel" as paper statements (column 4; lines 15-25). Examiner further notes that Kolling teaches these statements include electronic invoices. Examiner notes that this evidence supports the admitted prior art statement submitted by the Examiner that it is old and well known for "software developers to develop electronic forms that

Art Unit: 3627

look and feel just like their paper counterparts in order provide the end user with a system they are already familiar with.”

Applicant asserts that Cukor does not describe any end-user decision points for paying for goods received. Examiner once again states that Cukor does not need to show this. This limitation has been properly illustrated by Manners.

Conclusion

This is an RCE of applicant's earlier Application. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Art Unit: 3627


Any inquiry concerning this communication or earlier communications from the examiner should be directed to James A. Kramer whose telephone number is (703) 305-5241. The examiner can normally be reached on Monday - Friday (8AM - 5PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on (703) 305-4716. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James A. Kramer
Examiner
Art Unit 3627

jak


Richard Chilcot
Supervisory Patent Examiner
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